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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/804,531

03/19/2004

Richard A. Baker

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EXAMINER

RANKINS, WILLIAM E

ART UNIT

PAPER NUMBER

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04/03/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/804,531	Applicant(s) BAKER ET AL.	
	Examiner WILLIAM E. RANKINS	Art Unit 3696	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>11/3/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

The information disclosure statement (IDS) submitted on 11/03/2004 was filed in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

A review of the claims and search necessitated the rejections below.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: who or what and how is the 'creating an entry in the database' step performed? The step prior to creating an entry is 'indicating that the previously accepted trade was improperly accepted'. There exists a gap between the two steps defining how the entry is created.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

1. Claims 6 and 7 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.

35 USC 101 requires that in order to be patentable the invention must be a "new and useful process, machine, manufacture, *or* composition of matter, *or* any new and useful improvement thereof" (emphasis added). Applicant's claims mentioned above are intended to embrace or overlap *two* different statutory classes of invention as set forth in 35 USC 101. In the present case, claims 6 and 7 are directed toward a method but are dependent upon system claim 1. A claim of this type is precluded by the express language of 35 USC 101 which is drafted so as to set forth the statutory classes of invention in the alternative only. See MPEP 2173.05(p) section II.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

Patentability shall not be negated by the manner in which the invention was made.

1. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kuhn et al. (2004/0128223) in view of Penney et al. (2003/0069836).

As per claim 1;

Kuhn et al. discloses:

A computer system for supporting a derivatives clearinghouse (Abstract, Para. 0015), the clearinghouse having a plurality of participants, including a first participant and a second participant, the computer system comprising:

providing the list to the remote computer via the graphical user interface, wherein the list includes a previously executed trade that was carried out by the first and second participants or their respective customers and was accepted by the clearinghouse (Para. 0081, 0086);

maintaining a database of derivative trades that have been accepted by the clearinghouse (Para. 0024);

retrieving, from the database, data representing the list of accepted trades for which the first participant is responsible (Para. 0086);

Kuhn does not disclose:

a web server that performs steps comprising:

receiving a request for a web page from a remote computer;

providing a graphical user interface to the remote computer in response to the request;

receiving, through the graphical user interface, a request for a list of previously accepted derivatives trades in which the first participant or a customer of the first participant was a party;

receiving, from the remote computer, an input indicating that the previously executed trade was improperly accepted; and

a database server communicatively linked with the web server, wherein the database server performs steps comprising:

providing the data to the web server for use in creating the list; and
creating an entry in the database that represents an offsetting transaction that has the effect of negating the acceptance of the previously executed trade.

However, Penney et al. discloses:

Using the internet (Abstract) and a GUI (Para. 0026) to amend previously executed trades (Para. 0020), including derivatives (Para. 0005), and creating offsetting transactions (Para. 0055).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of this invention to combine the methods of Kuhn et al. and Penney et al.

One of ordinary skill in the art at the time of this invention would have been motivated to do so in order to provide a single source for trade management, settlement and amendments.

As per claim 2;

Kuhn et al. does not disclose:

The system of claim 1,

wherein the remote computer is a first remote computer and the graphical user interface is a first graphical user interface,

wherein the web server performs further steps comprising:

presenting a second graphical user interface to a second remote computer; and

querying the second participant, via the second graphical user interface,

regarding whether the clearinghouse's acceptance of the previously executed trade should be negated;

wherein the database server performs the creating step only if the second participant indicates that the clearinghouse's acceptance of the previously executed trade should be negated.

However, Penney et al. discloses:

A system where the customer submits amendments through a GUI and a provider responds to the submission through a GUI and launches an amendment tool (Para's. 0086 and 0092).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of this invention to combine the methods of Kuhn et al. and Penney et al. One of ordinary skill in the art at the time of this invention would have been motivated to do so in order to allow the amended transactions to take place in real time by using the

internet instead of old manual systems such as the telephone and fax machines.

As per claim 3;

Kuhn et al. does not disclose:

The system of claim 1, wherein the database server performs further steps comprising:

receiving a structured query language search command; and

searching the database in accordance with the structured query language search command, wherein the retrieving step is performed as result of the searching step.

However, Penney et al. discloses:

Database access request statements in SQL (Para. 0101), searching the database (Para. 0124) and exporting search results (Para. 0170).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of this invention to combine the methods of Kuhn et al. and Penney et al. One of ordinary skill in the art at the time of this invention would have been motivated to do so in order to access and create amendments.

As per claim 4;

Kuhn discloses:

The system of claim 1,

wherein the web server receives user-entered data regarding the previously executed trade (Para. 0130);

wherein the clearinghouse stores data concerning the previously execute trade in the database (Para. 0133); and

Kuhn et al. does not disclose:

wherein the user-entered data is incorrect;

wherein, subsequent to web server receiving the user-entered data, the clearinghouse accepts the previously executed trade;

wherein the data includes an indication that the previously executed trade has been accepted by the clearinghouse.

Penney et al. discloses:

A system where the user submits a transaction where an amendment will be provided in the second phase of the operation and the input is confirmed by the provider (Para. 0015).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of this invention to combine the methods of Kuhn et al. and Penney et al. One of ordinary skill in the art at the time of this invention would have been motivated to do so in order to receive and negotiate the details of amendments to the transaction.

Claim 5 is rejected under the same rationale used to reject claims 2, 3 and 4.

As per claim 6;

Kuhn et al. does not disclose:

The method of claim 1, wherein the web server displays, via the graphical user interface, an alert message relating to post-trading activity.

However, Penney et al. discloses:

An alert sent to the provider when the amendment arrives (Para. 0084).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of this invention to combine the methods of Kuhn et al. and Penney et al. One of ordinary skill in the art at the time of this invention would have been motivated to do so in order to promote a response to the trade amendment.

As per claim 7;

Kuhn et al. does not disclose:

The method of claim 1, wherein the web server displays, via the graphical user interface, an alert message indicating that all post-trading activity needs to stop.

However, Penney et al. discloses:

An alert regarding post trading activity (Para. 0084) and the customer stopping post trade negotiations until a response to the amendment from the provider is received (Para. 0174).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of this invention to combine the methods of Kuhn et al. and Penney et al. One of ordinary skill in the art at the time of this invention would have been motivated to do so in order to allow the system to process the amendment per the desired modifications.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William E. Rankins whose telephone number is 571-270-3465. The examiner can normally be reached on M-F 7:30 AM - 5:00 PM, off alt Fridays beg 6/15/07.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Dixon can be reached on 571-272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/W. E. R./

Examiner, Art Unit 3696
3/19/2008

/Daniel S Felten/

Primary Examiner, Art Unit 3696

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